REMARKS

1. Claims 1-20 are in the case; claims 15, 19 and 20 have been amended. I do not believe that any additional filing fees are due; however, should there be any additional fees due, please charge Deposit Account No. 11-0245. No new matter has been added by the amendments to the claims.

2. 35 U.S.C. §112, First Paragraph Rejection. Claim 15 is objected to under 35 U.S.C. §112, first paragraph, as failing to provide an enabling disclosure. The Examiner states that the first two steps of original claim 15 are "critical or essential to the practice of the invention but not included in the claim(s) is not enabled by the disclosure." The claims in a patent application form part of the specification. 35 U.S.C. §112, second paragraph. Accordingly, disclosing the step of providing a financial institution is included in the specification because it is listed as an element of a claim. The case cited by the examiner, *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976), is not applicable because it is a case in which an essential step was omitted from the claims and therefore the claims were rejected under the first paragraph of 35 USC 112 as not being enabled. In this case, Examiner is objecting to the addition of limitations to the claims. If Examiner still believes there is no support for this step in the specification, the specification specifically states that "The method includes a business service that is offered to banks and other clientele…." page 3, lines 15 – 16. Applicant submits that a bank is a non-limiting example of a financial institution.

Additionally, the Examiner states that the term "financial" appears in the specification and is not clearly defined. The word "financial" has an ordinary meaning that would be

understood by a person of ordinary skill in the art. Terms in a patent claim must be given their ordinary and customary meaning unless the plain meaning is inconsistent with the specification. MPEP 2111.01 and *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004). Additionally, the ordinary and customary meaning is defined as being the meaning that a person of ordinary skill in the art would give the term at the time of the invention. MPEP 2111.01 and *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (*en banc*). Therefore, while a patentee can be his or her own lexicographer, a patentee is not required to define terms that have an ordinary and customary meaning and as such would be understood by a person of ordinary skill in the art. Applicant submits that the term "financial" has an ordinary and customary meaning to a person of ordinary skill in the art and that meaning should be applied to the term "financial" as it is used in claim 15.

3. 35 U.S.C. §112, Second Paragraph Rejection. Claim 15 is also objected to under 35 USC 112, second paragraph. The Examiner states that claim 15 is incomplete because it omits essential structural cooperative relationships of elements which amount to a gap between the necessary structural connections. Claim 15 has been amended to eliminate the term "population". As amended, the financial institution comprises individual customers. Claim 15 states that "said customers being willing to grant to said financial institution rights

in collateral in exchange for said financial assistance". The term "rights" as it pertains to collateral given in exchange for financial assistance has an ordinary and customary meaning to a person of ordinary skill in the art. Applicant submits that the term "rights" as it pertains to collateral given in exchange for financial assistance has an ordinary and customary meaning to a person of ordinary skill in the art and that meaning should be applied to the term "financial" as it is used in claim 15. When the ordinary and customary meaning is applied to the term "rights" as it pertains to collateral given in exchange for financial assistance, there is no gap between the necessary structural cooperative relationships of the elements.

4. 35 U.S.C. §102 Rejection based on Apgar, IV. Claims 1-5, 9, 11, 12, 17, 19, and 20 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Apgar, IV (US Pat. No. 5,680,305). Apgar, IV does not anticipate any of the claims because Apgar does not teach assessing the environmental risk by investigating the state of current or future regulatory compliance, as is required by claim 1 of the current application. Apgar, IV states that the risk indicator is based "on at least one of (i) the location's proximity to naturally occurring and man-made environmental hazards, such as toxic waste sites and radon sites as registered with the Environmental Protection Agency (EPA); (ii) other hazardous indicators, such as asbestos exposure, or building age for determining asbestos exposure, if the presence

of asbestos in a real estate is uncertain; (iii) the tenancy status of the Business Entity in the real estate in comparison to other business entities within a similar SIC code; (iv) the financial encumbrances of the Business Entity for the real estate; and (v) other measures that indicate the financial, market and/or environmental risks associated with the real estate." Apgar, IV col. 13, lines 31-44. Apgar, IV does not disclose determining the current and future regulatory compliance as a factor in assessing the environmental risk, and therefore Apgar, IV does not anticipate claim 1 or claim 17 because claims 1 and 17 both require that a third indicator of risk be associated with the current state of regulatory compliance and the fourth indicator of risk be associated with the future requirements for regulatory compliance. Additionally, Apgar, IV does not anticipate any dependant claims that relate back to claim 1. Accordingly, Apgar, IV does not anticipate claims 2-5, 9, 11, and 12. Accordingly, applicant respectfully requests that Examiner withdraw the rejections of claims 1-5, 9, 11, 12, and 17.

Claims 19 and 20 have been amended so that environmental risk comprises the current state of regulatory compliance. Accordingly, claims 19 and 20 are no longer anticipated by Apgar, IV because Apgar, IV does not disclose that the environmental risk includes the current state of regulatory compliance. Accordingly, applicant respectfully requests that Examiner withdraw the rejections of claims 19 and 20.

5. 35 U.S.C. §103 Rejection based on Apgar, IV and Burton. The Examiner argues that claim 6 is obvious and unpatentable over Apgar, IV in view of Burton (U.S. Pat. No. 6,782,321 B1). Claim 6 is dependent from claim 5 which is dependent from claim 3 which is dependent from claim 1. As indicted above, Apgar IV does not disclose all of the limitations present in claim 1. Additionally, Burton merely discloses that the procedures used to select and conduct aquifer tests are well established in ASTM standards. However, Burton does not disclose that the ASTM standards are used to derive indicators. Instead, Burton discloses that certain ASTM standards include procedures for selecting aquifer tests. Therefore, claim 6 is not obvious in view of Apgar, IV over Burton because combining these two references does not result in the applicant's invention. Accordingly, applicant respectfully requests that Examiner withdraw the rejection of claim 6.

6. 35 U.S.C. §103 Rejection based on Apgar, IV and McDaniel. The Examiner argues that claim 6 is obvious and unpatentable over Apgar, IV in view of McDaniel (U.S. Pat. No. 5,105,365). Claim 10 is dependent from claim 1. As discussed above, Apgar, IV does not disclose all of the limitations of claim 1. Additionally, McDaniel does not teach that the indicators are alphabetical references. Placing items in alphabetical order does not disclose using an alphabetical reference for an indicator. When placing things in alphabetical order, the placement on the list will correspond to the spelling of the particular reference.

However, as in the present invention, assigning an alphabetical reference to an indicator is not dependent on the spelling of the indicator or any other reference. Therefore, the combination of references cited by Examiner does not result in the limitations disclosed in claim 10 of the present invention. Accordingly, applicant respectfully requests that Examiner withdraw the rejection of claim 10.

7. 35 U.S.C. §103 Rejection based on Apgar, IV and Naval Air. The Examiner argues that claims 7, 8, 13-16, and 18 are obvious and unpatentable over Apgar, IV in view of "Annual Environmental Performance Report: Naval Air Engineering Station Lakehurst New Jersey," October 30, 2002 ("Naval Air"). Claims 7, 8, 13, and 14 are dependent from claim 1. As discussed above, Apgar, IV does not disclose all of the limitations in claim 1 of the current invention.

Additionally, Naval Air does not disclose that a knowledgeable person reviews and adjusts the indicators. Naval Air discloses that the station uses a tailored version of an ISO standard (section 4.1). However, Naval Air does not disclose that the indicators produced as a result of the audit are reviewed and adjusted by a knowledgeable person. Claim 7, which depends on claim 1, discloses that the indicators that were originally assigned to the four categories (piece of land, service operation, current state of regulatory compliance, and future state of regulatory compliance) are reviewed and adjusted by a knowledgeable person.

Therefore, combining the two references cited by Examiner does not result all of the limitations contained in claim 7.

Naval Air also does not disclose that a listing of required environmental permits be included in the report, as is disclosed in claim 13 of the present invention. Naval Air lists whether the station has to meet reporting requirements under the Emergency Planning and Community Right-to-Know Act (EPCRA). Naval Air does not list all the environmental permits that the station is required to obtain regardless of whether the station has in fact obtained the environmental permits. Combining Apgar, IV and Naval Air does not result in all of the limitations contained in claim 13.

Claim 15 includes the limitation that an environmental auditor evaluates the environmental risk associated with collateral proffered by customers of the financial institution. Naval Air does not disclose an environmental auditor evaluating environmental risk associated with collateral for a financial institution. In Naval Air, the station is only monitoring its own environmental risk and compliance. The station does not monitor the environmental risk of third parties, especially for collateral. Therefore, combining Apgar, IV with Naval Air does not disclose all of the limitations contained in claim 15. Claims 16 and 18 are dependent from claim 15. Additionally, claim 18 discloses that least a portion of the environmental audit is conducted by personnel at a regional office and then reported back to

a headquarters. Naval Air does not teach that there are regional offices and headquarters. The Public Works Environmental Branch discussed in Naval Air is a department that appears to be located on the station and reports to the commanding officer of the station. Therefore, there are no regional offices or headquarters. The station has merely consolidated the environmental auditing in one department and Naval Air does not contain the limitations of claim 18. Accordingly, applicant respectfully requests that Examiner withdraw the rejections of claims 15, 16, and 18.

8. Conclusion. Based on the above amendments and remarks I believe that all of the claims remaining in the case are allowable and an early Notice of Allowability is respectfully requested. If the Examiner believes a telephone conference will expedite the disposition of this matter he is respectfully invited to contact this attorney at the number shown below.

Respectfully submitted,

Pamela A. Baxter
Reg. No. 59,633
KEAN, MILLER, HAWTHORNE, D'ARMOND,
MCCOWAN & JARMAN, L.L.P.
P.O. Box 3513

Baton Rouge, Louisiana 70821-3513
Telephone: (225) 387-0999
Fax: (225) 388-9133
Email: pamela.baxter@keanmiller.com
Website: www.keanmiller.com

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